

### Remarks

#### Objections to the Abstract

The Applicant has amended the abstract to overcome the Examiner's objections to the abstract. Accordingly, the Applicant respectfully requests withdrawal of the Examiner's objections to the abstract.

#### Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1, 2, 4, 6, 10, 12, 14 and 21 under 35 U.S.C. § 102(b) as anticipated by U.S. patent 5,703,700 issued to Birgmeir et al (hereinafter referred to as Birgmeir). The Applicant respectfully requests careful consideration of the following explanation in support of the traversal of these rejections under 35 U.S.C. § 102(b).

#### Rejections of Claims 1, 2, 4, and 6 Under 35 U.S.C. § 102(b)

From item 2 (the first two sentences at the top of page 3 of the current office action) the Examiner seems to assert that the limitations of **"alerting a user** if the document formatting is not optimized for transparency printing" (emphasis added) are disclosed at column 5, lines 7-14 of Birgmeir. The Applicant respectfully contends that the referenced section of Birgmeir does not disclose these limitations.

Column 5, lines 7-14 of Birgmeir discloses that "[t]he keys 12a-12f **are activated by an operator** 11 in accordance with the operator's observations about the nature of the master 4. For instance, the key 12a can be activated to mark a properly exposed master, the key 12b where a portion of a master significant for an image is light, the key 12c where a portion of a master significant for an image is dark, the key 12d for a master exposed using artificial light, and so on." (emphasis added). In contrast to the limitations of claim 1 recited above, this section of Birgmeir cited by the Examiner does not disclose "alerting a user" by the "copy apparatus" of shown in Figure 1 of Birgmeir. Rather, this section of Birgmeir discloses that the "data entry unit or keyboard 12"

is to be "**activated by an operator** 11 in accordance with the operator's observations". (emphasis added) The Applicant respectfully contends that "alerting a user" does not read upon "activated by an operator" or the other subject matter disclosed in the cited section of Birgmeir.

As the Examiner is well aware, according to MPEP SECTION 2131, quoting from a federal circuit case, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because sections of Birgmeir cited by the Examiner do not disclose all the limitations of claim 1, a valid prima facie anticipation rejection of claim 1 over Birgmeir has not been made. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claim 1 under 35 U.S.C. § 102 (b).

Claims 2, 4, and 6 are dependent, either directly or indirectly, upon claim 1 and thereby incorporate all the limitations of claim 1. Therefore, for at least the reason that a valid prima facie anticipation rejection of claim 1 over Birgmeir has not been made, a valid prima facie anticipation rejection of claims 2, 4, and 6 over Birgmeir has not been made.

Rejections of Claims 10 and 12 Under 35 U.S.C. § 102(b)

From item 2 (the last sentence of the fourth full paragraph on page 3 of the current office action) the Examiner seems to assert that the limitations of "**means for alerting a user** if the document formatting is not optimized for transparency printing" (emphasis added) are disclosed at column 5, lines 7-14 of Birgmeir. The Applicant respectfully contends that the referenced section of Birgmeir does not disclose these limitations.

Column 5, lines 7-14 of Birgmeir discloses that "[t]he keys 12a-12f **are activated by an operator** 11 in accordance with the operator's observations about the nature of the master 4. For instance, the key 12a can be activated to mark a properly exposed master, the key 12b where a portion of a master significant for an image is light, the key 12c where a portion of a master significant for an image is dark, the key 12d for a master exposed using artificial

light, and so on." (emphasis added). In contrast to the limitations of claim 10 recited above, this cited section of Birgmeir does not disclose "means for alerting a user" by the "copy apparatus" of shown in Figure 1 of Birgmeir. Rather, this section of Birgmeir discloses that the "data entry unit or keyboard 12" is to be **"activated by an operator 11** in accordance with the operator's observations". (emphasis added) The Applicant respectfully contends that function recited in "means for alerting a user" does not find equivalence in disclosure reciting activation "by an operator 11 in accordance with the operator's observations" or the other functions disclosed in the cited section of Birgmeir. That is, the Applicant contends, an operator activating a "data entry unit or keyboard" is not the equivalent to the function of "alerting a user".

As the Examiner is well aware, according to MPEP SECTION 2183, making a prima facie case of equivalence includes the Examiner finding a prior art element that "performs the function specified in the claim". Because the section of Birgmeir cited by the Examiner does not disclose the function of the above recited limitations of claim 10, a valid prima facie anticipation rejection of claim 10 over the cited sections of Birgmeir has not been made. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claim 10 under 35 U.S.C. § 102 (b).

Claim 12 is directly dependent upon claim 10 and thereby incorporates all the limitations of claim 10. Therefore, for at least the reason that a valid prima facie anticipation rejection of claim 10 over Birgmeir has not been made, a valid prima facie anticipation rejection of claim 10 over Birgmeir has not be made. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claim 12 under 35 U.S.C. § 102 (b).

#### Rejections of Claim 14 Under 35 U.S.C. § 102(b)

From item 2 (the last sentence of the first paragraph on page 4 of the current office action) the Examiner seems to assert that the limitations of **"alerting a user** if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning

resolution is inappropriate" (emphasis added) are disclosed at column 5, lines 10-14 of Birgmeir. The Applicant respectfully contends that the referenced section of Birgmeir does not disclose these limitations.

Column 5, lines 10-14 of Birgmeir discloses that "the key 12a can be activated to mark a properly exposed master, the key 12b where a portion of a master significant for an image is light, the key 12c where a portion of a master significant for an image is dark, the key 12d for a master exposed using artificial light, and so on." (emphasis added). In contrast to the limitations of claim 14 recited above, this section of Birgmeir cited by the Examiner does not disclose "alerting a user" by the "copy apparatus" of shown in Figure 1 of Birgmeir. Rather, this section of Birgmeir discloses that "the key 12a can be activated" Based upon other disclosure of this paragraph, the activated appears to be performed by the "operator". The Applicant respectfully contends that "alerting a user" does not read upon "the key 12a can be activated" or the other subject matter disclosed in the cited section of Birgmeir.

As the Examiner is well aware, according to MPEP SECTION 2131, quoting from a federal circuit case, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because sections of Birgmeir cited by the Examiner do not disclose all the limitations of claim 14, a valid prima facie anticipation rejection of claim 14 over Birgmeir has not been made. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claim 14 under 35 U.S.C. § 102(b).

#### Rejections of Claim 21 Under 35 U.S.C. § 102(b)

From item 2 (the full paragraph of item 2 on page 4 of the current office action) the Examiner seems to assert that the limitations of "**means for alerting a user** if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate" (emphasis added) are disclosed at column 5, lines 10-14 of Birgmeir. The Applicant respectfully contends that the referenced section of

Birgmeir does not disclose these limitations.

Column 5, lines 10-14 of Birgmeir discloses that "the key 12a can **be activated** to mark a properly exposed master, the key 12b where a portion of a master significant for an image is light, the key 12c where a portion of a master significant for an image is dark, the key 12d for a master exposed using artificial light, and so on." (emphasis added). In contrast to the limitations of claim 21 recited above, this cited section of Birgmeir does not disclose "means for alerting a user" by the "copy apparatus" of shown in Figure 1 of Birgmeir. Rather, this section of Birgmeir discloses that the "the key 12a can **be activated**". Based upon other disclosure of this paragraph, the activated appears to be performed by the "operator". The Applicant respectfully contends that function recited in "means for alerting a user" does not find equivalence in disclosure reciting activation "the key 12a can be activated" or the other functions disclosed in the cited section of Birgmeir. That is, the Applicant contends, an operator activating a "the key 12a" is not equivalent to the function of "alerting a user".

As the Examiner is well aware, according to MPEP SECTION 2183, making a prima facie case of equivalence includes the Examiner finding a prior art element that "performs the function specified in the claim". Because the section of Birgmeir cited by the Examiner does not disclose the function of the above recited limitations of claim 21, a valid prima facie anticipation rejection of claim 21 over the cited sections of Birgmeir has not been made. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claim 21 under 35 U.S.C. § 102 (b).

Rejections of Claims 3, 5, 7, 8, 9, 11, 13, 15, 16, 17, 18, 19, 20, 22, and 23  
Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 3, 5, 7, 8, 9, 11, 13, 15, 16, 17, 18, 19, 20, 22, and 23 as obvious under 35 U.S.C. § 103 (a) in view of Birgmeir in combination with one of U.S. patent number 6,753,976 issued to Torpey et al (hereinafter referred to as Torpey), U.S. patent number 6,552,813 issued to Yacoub (hereinafter referred to as Yacoub), U.S. patent number 5,381,526

issued to Ellson (hereinafter referred to as Ellson), and U.S. patent number 5,283,671 issued to Stewart et al (hereinafter referred to as Stewart). The Applicant respectfully requests careful consideration of the following explanations in support of traversing these rejections.

Rejections of Claims 7, 8, and 9 Under U.S.C. § 103(a)

In item 6 on page 6 of the office action, the Examiner states that "Birgmeir, Regarding claim 7, does not teach alerting a user if the document formatting is not optimized for transparency printing comprising facilitating presentation of a warning dialogue box to the user. ***Yacoub does teach alerting a user if the document formatting is not optimized for transparency printing*** comprising facilitating presentation of a warning dialogue box to the user (column 10, lines 5-27)." (emphasis added) The Applicant respectfully disagrees with the Examiner's conclusion about what the cited section of Yacoub discloses.

As stated in column 9, lines 12-15, of Yacoub "the virtual printer brings up ***a dialogue or menu*** checking for the user's preferences. A menu or dialogue box (described below) will appear allowing the user to select between speed and quality and color or black and white." (emphasis added). Also, as stated in column 9, lines 65 through column 10 line 4 of Yacoub, "[f]urther, in the circumstance where high-end desktop laser printer 412 returns a busy signal to client station A 420, the ***user may be notified with a further dialogue box notifying him that high-end desktop laser printer 412 is busy*** and ask the user whether or not to wait for his print job to be completed at that printer or, in the alternative, whether to have the virtual printer select another printer instead." (emphasis added) And, as stated in Yacoub column 10, lines 6-20, "***the dialogue box will also contain a range of image quality which the user may select as preferred***. If the user prefers a detailed graphical image then the next question will be whether or not that image will be in black-and-white (or gray-scale) or in color. If a high quality color image is required then the virtual printer would first find that color laser printer 410 is the most appropriate printer in terms

of quality for the job. ***In case the color laser printer 410 has an error or is busy and the user will settle for less image quality then the next selection by the virtual printer would be color ink jet 414,*** which while not having the resolution of color laser printer 410, ***may have the capability to print at a faster rate and also have the capability, unlike color laser printer 410 to utilize a different paper type, such as a transparency used in an overhead projector.***" (emphasis added)

The Applicant contends that the cited sections of Yacoub in the previous paragraph do not disclose the limitations of claim 1 (Incorporated by reference into claims 7, 8, and 9) of ***"alerting a user if the document formatting is not optimized for transparency printing"***. (emphasis added) The Applicant contends that the section of Yacoub cited by the Examiner merely discloses that "unlike color laser printer 410", "color inkjet 414" has the "capability" "to utilize" "a transparency". Furthermore, in the sections of Yacoub cited above, the "dialogue" referenced seems to be directed to: one of a) "checking for the user's preferences" b) "notifying him that high-end desktop laser printer 412 is busy" c) containing "a range of image quality which the user may select as preferred". The Applicant could not locate disclosure in these sections of Yacoub cited upon which the limitations of claim 1 of "alerting a user if the document formatting is not optimized for transparency printing" read. If the Examiner believes the cited sections of Yacoub make such a disclosure, the Applicant respectfully requests that the Examiner specifically identify this disclosure and provide a detailed explanation of why the Examiner believes the recited limitations of claim 1 reads upon this disclosure.

As the Examiner is well aware, MPEP section 2143.03 states that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" and states that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." Because claims 7, 8, and 9 include limitations not disclosed in the cited sections of Birgmeir or Yacoub, a valid *prima facie* obviousness rejection of claims 7, 8, and 9 has not been made for at least this reason. Accordingly, the

Applicant respectfully requests withdrawal of the rejections of claims 7, 8, and 9 under 35 U.S.C. § 103(a).

Rejections of Claims 18, 19, and 20 Under U.S.C. § 103(a)

As stated in item 10 on page 9 of the office action by the Examiner, "Yacoub does teach the step of alerting a user if the scanning resolution is not appropriate for scanning a transparency comprises facilitating presentation of a warning dialogue box to the user (column 10, lines 5-27)." The Applicant respectfully disagrees with the Examiner's conclusion about what the cited section of Yacoub discloses.

Claim 14, upon which claims 18, 19, and 20 depend either directly or indirectly, recites "**alerting a user if the scanning resolution is not appropriate** for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate". (emphasis added) However, the sections of Yacoub cited by the Applicant above do not disclose "alerting a user if the scanning resolution is not appropriate". Rather the cited sections of Yacoub disclose the features mentioned in the traversal of the rejections of claims 7, 8, and 9.

As the Examiner is well aware, MPEP section 2143.03 states that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" and states that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." Because claims 18, 19, and 20 include limitations not disclosed in the cited sections of Birgmeir or Yacoub, a valid *prima facie* obviousness rejection of claims 18, 19, and 20 has not been made for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 18, 19, and 20 under 35 U.S.C. § 103(a).

Rejections of Claims 3, 5, 11, 13, 15, 16, 17, 22, and 23 Under 35 U.S.C. § 103(a)

Claims 3 and 5 (which incorporate limitations of claim 1 either directly or



indirectly) are rejected over Birgmeir in view of Torpey. However, because the sections Birgmeir and Torpey cited by the Examiner do not include, as discussed above, disclosure upon which the limitations of claim 1 reciting "alerting a user if the document formatting is not optimized for transparency printing" read, a valid prima facie obviousness rejection of claims 3 and 5 has not been made for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 3 and 5 under 35 U.S.C. § 103(a).

Claims 11 and 13 (which incorporate limitations of claim 10 either directly or indirectly) are rejected over Birgmeir in view of Torpey. However, because the sections Birgmeir and Torpey cited by the Examiner do not include, as discussed above, disclosure upon which the limitations of claim 10 reciting "means for alerting a user if the document formatting is not optimized for transparency printing" read, a valid prima facie obviousness rejection of claims 11 and 13 has not been made for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 11 and 13 under 35 U.S.C. § 103(a).

Claims 15, 16, and 17 (which incorporate limitations of claim 14 either directly or indirectly) are rejected over Birgmeir in view of, respectively, Ellson, Stewart, and Torpey. However, because the sections Birgmeir and Ellson, Stewart, and Torpey cited by the Examiner do not include, as discussed above, disclosure upon which the limitations of claim 14 reciting "alerting a user if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate" read, a valid prima facie obviousness rejection of claims 15, 16, and 17 has not been made for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 15, 16, and 17 under 35 U.S.C. § 103(a).

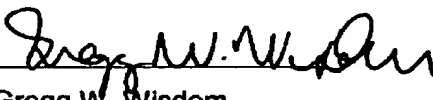
Claims 22 and 23 (which incorporate limitations of claim 21 either directly or indirectly) are rejected over Birgmeir in view of, respectively Ellson and Stewart. However, because the sections Birgmeir, Ellson, and Stewart cited by the Examiner do not include, as discussed above, disclosure upon which the

limitations of claim 21 reciting "means for alerting a user if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate" read, a valid prima facie obviousness rejection of claims 22 and 23 has not been made for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 22 and 23 under 35 U.S.C. § 103(a).

### Conclusion

The Applicants respectfully contend that in view of the amendments to the abstract and the explanation traversing the rejections of the claims, the subject application is in a condition for allowance. Allowance is respectfully requested.

Respectfully submitted,  
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